

REMARKS

Claims 1-22, 40-49, 51, 53, and 55-57 were and remain pending. Reconsideration and allowance of these claims in view of the following remarks are respectfully requested.

I. INTERVIEW SUMMARY

Applicants appreciate the courtesy that the Examiner extended via a February 25, 2008 interview. Pursuant to MPEP 713.04, Applicants hereby adopt and incorporate by reference the Examiner's summary of the interview.

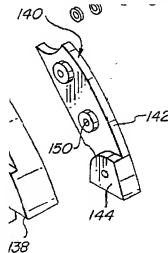
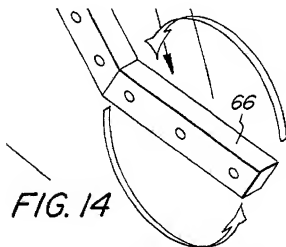
II. OBVIOUSNESS REJECTION

Claims 1-22, 40-49, 51, 53, and 55-57 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,992,023 ("the '023 patent"). Applicants respectfully traverse this rejection. Independent claims 1, 3, 4, 5, 7, 10, 12, 14, 16, 18, 19, and 20 each recite, among other things, an "indexable wear plate/piercing tip insert" with "a metal tip portion disposed at each of said two ends, each said tip portion protruding laterally with respect to a surface of said central region." Independent claim 42 similarly recites, among other things, an "indexable wear plate/piercing tip insert" with "metal tip portion disposed at each of said two longitudinal ends, each said tip portion protruding laterally with respect to a surface of said central region." The Examiner asserts that because the '023 patent discloses a "a wear plate/piercing tip insert 140 having one cutting tip 144" and also discloses indexable blade insert member 116, "it would have been obvious to one skilled in the art at the time the invention was made to provide the wear plate/pierce tip insert 140 the geometric configuration as taught in the blade 116 (which is to have two cutting tips) so that both ends of the wear plate/pierce tip insert 140 can be used to reduce the spare part of the wear plate/pierce tip insert." 2/11/08 Office Action, pp. 2-3.

Applicants traverse the Examiner's assertion that it would have been obvious to one of ordinary skill in the art, in view of the '023 patent, to add a second cutting tip 144 to the piercing tip 140 to make it indexable. Specifically, (A) there was no disclosure, suggestion, or other reason to make the proposed modification to the '023 patent's piercing tip, (B) the obviousness rejection relies on impermissible hindsight, (C) the '023 patent teaches away from the proposed modification, and (D) there is compelling objective evidence of non-obviousness.

A. There Was No Disclosure, Suggestion, or Other Reason To Make The Proposed Modification

First, the '023 patent includes no suggestion or other reason to add an additional nose piece 144 to an opposite side of the piercing tip 140 to make the piercing tip 140 indexable. *See* the '023 patent, col. 6, lines 51-63. The indexability of the blade insert member 66 in the '023 patent would not have made it obvious to make the disparate one-sided piercing tip 140 indexable. The Examiner improperly equates the known indexability of a blade insert member 66 with the suggestion to make the specific wear plate/piercing tip 140 indexable by adding a second laterally-protruding nose piece 144. In fact, blade insert members 63, 66, 114, 116 in the '023 patent are categorically different than the wear plate/piercing tip 140 in the '023 patent.



The '023 Patent, FIGS. 10 and 14 (excerpted)

The categorical design and functional differences between the '023 patent's blade insert members 64, 66, 114, 116 and the piercing tip 140 demonstrate that it would not have been obvious to one of ordinary skill in the art to have applied the indexability of the simple blade insert members 64, 66, 114, 116 to the disparate piercing tip 140:

- Blade insert members 63, 66, 114, 116 have simple geometric configurations whose simple shapes lend themselves to indexability. For this reason, blade insert members have been indexable for years. In contrast, the piercing tip 140 in the '023 patent has a much more complex shape (e.g., laterally protruding nose piece 144 and bosses (surrounding apertures 150)). Such protrusion(s) categorically distinguish the piercing

tip 140 from simple blade insert members 64, 66, 114, 116 in the eyes of one of ordinary skill in the art.

- The simple geometry of the blade insert members 64, 66, 114, 116 makes it easy for the stored edge of the blade insert members 64, 66, 114, 116 to mate with the blade seats in the jaw. In fact, these stored edges provide part of the structural connection between the jaw and the blade insert members 64, 66, 114, 116. In contrast, the laterally protruding tip portion 144 and bosses on the piercing tip 140 prevent and/or complicate analogous use of a stored tip portion 144 if the piercing tip 140 were to be made indexable by adding a second tip portion 144, as proposed by the Examiner.
- The piercing tip 140 is generally elongated in the direction of force and/or movement of the upper jaw, while the blade insert members 64, 66, 114, 116 are generally elongated in a direction perpendicular to the direction of force and/or movement of the upper jaw. Consequently, consideration of how forces transfer from these blade insert members 64, 66, 114, 116 and piercing tip 140 to the jaw is quite different.
- The complicated geometry of the piercing tip 140 (e.g., the laterally protruding nose piece 144 and laterally protruding bosses) complicates the design of the seat in the upper jaw for the piercing tip 140. This complication is exacerbated by the fact that the piercing tip 140 extends upwardly and then laterally into the main body of the upper jaw, which implicates further structural considerations with respect to the upper jaw.

These categorical design and functional differences between the '023 patent's blade insert members 64, 66, 114, 116 and the piercing tip 140 demonstrate that it would not have been obvious to one of ordinary skill in the art to have applied the indexability of the simple blade insert members 64, 66, 114, 116 to the disparate piercing tip 140.

The '023 patent's failure to make the Examiner's proposed modification obvious is further emphasized by the '023 patent's glaring failure to teach or suggest making the piercing tip 140 indexable, despite including detailed discussions and figures disclosing the indexability of the blade insert members 64, 66, 114, 116. *See* the '023 patent, FIGS. 4, 13, & 14, and col. 7, lines 19-44. If the Examiner's proposed modification to the piercing tip 140 was obvious based solely on the '023 patent, the '023 patent would have mentioned or suggested such a modification in view of the '023 patent's focus on indexability. The '023 patent suggests no such modification to the piercing tip 140 because such a modification was not suggested or

contemplated by the '023 patent or obvious to one of ordinary skill in the art in view of the '023 patent.

To the extent that the '023 patent would have been obvious to make a piercing tip indexable (Applicants dispute this), Applicants submit that one of ordinary skill in the art would have started from a piercing tip with a simpler geometry than that of the piercing tip 140 of the '023 patent, particularly in view of the fact that the '023 patent only discloses the indexability of simple geometry blade insert members 64, 66, 114, 116. The present claims do not recite just any indexable piercing tip. Rather they recite a specific piercing tip with a specific structure, i.e., an "indexable wear plate/piercing tip insert" with "a metal tip portion disposed at each of said two ends, each said tip portion protruding laterally with respect to a surface of said central region" (independent claims 1, 3, 4, 5, 7, 10, 12, 14, 16, 18, 19, and 20) or an "indexable wear plate/piercing tip insert" with "metal tip portion disposed at each of said two longitudinal ends, each said tip portion protruding laterally with respect to a surface of said central region" (claim 40). Making a conventional simple geometry piercing tip indexable would not result in the combination of recitations in the pending claims.

B. The Proposed Modification Relies On Impermissible Hindsight

Second, the Examiner's proposed modification to the '023 patent's piercing tip 140 is improper because it relies on impermissible hindsight. Applicants submit that the Examiner's rationale for applying the indexability of the blade insert member 66 to the piercing tip 140 in the '023 patent comes directly from the Applicants' present application, rather than the '023 patent, which relates only to the indexability of much simpler geometry blade insert members, as opposed to piercing tips, much less the complex piercing tip geometry of the tip 140 in the '023 patent.

C. The '023 Patent Teaches Away From The Proposed Modification

Third, the Examiner's proposed modification to the piercing tip 140 of the '023 patent was non-obvious because it would have eliminated the "rhino horn" (identified by an added arrow in the below copy of FIG. 10 of the '023 patent) in the shears shown in the '023 patent. A "rhino horn" is a tine on a front, upper part of an upper jaw of a shears.

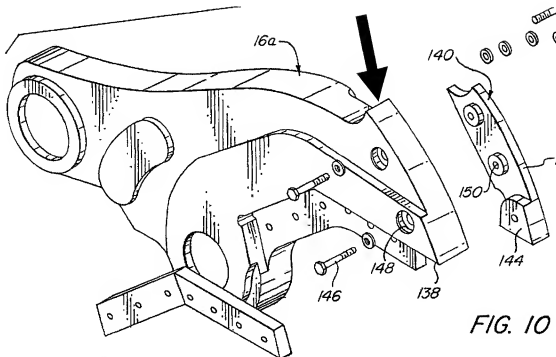


FIG. 10

The '023 Patent (Excerpt; arrow added)

A shears operator uses the rhino horn to manipulate material (e.g., to better position material to be sheared, to move material, to remove interfering debris, etc.). In the shears shown in FIG. 10 of the '023 patent, the rhino horn (not numbered) is formed by an upper part of the upper jaw 16 and an upper part of the piercing tip 140. Adding a second nose piece 144 to the piercing tip 140, as proposed by the Examiner, would have interfered with or eliminated the rhino horn.

The Examiner responds to this argument by asserting that:

[I]t would have been obvious to one skilled in the art not to expose the second cutting tip above the top of the moveable jaw 16 to interfere with the function of pulling roots of the moveable jaw. Fig. 2 teaches not exposing a wear plate 122 above the top of the moveable jaw 16 so that the wear plate 122 does not interfere with the function of pulling roots of the moveable jaw.

2/11/08 Office Action, p. 3. Applicants specifically traverse the Examiner's assertion for at least two reasons.

First, the wear plate 122 in FIG. 2 of the '023 patent is not a piercing tip and provides no motivation, suggestion, or other reason to make or not make any modification to a disparate piercing tip. To the extent that the Examiner intended to refer to the nose blade/piercing tip 124 in FIG. 2 of the '023 patent, the structural differences between the piercing tip 124 and the piercing tip 140 would prevent one of ordinary skill from using any teaching relating to the tip

124 in connection with the tip 140. To the extent that the '023 patent would have made it obvious to make a piercing tip indexable (Applicants dispute this), Applicants submit that one of ordinary skill in the art would have applied such indexability directly to the tip 124, and not to the tip 140.

Second, positioning the second cutting tip of the proposed modified piercing tip 140 below the top of the moveable jaw, as proposed by the Examiner to avoid interference with the rhino horn, would require a central portion of the upper jaw to be hollowed out to provide space for the laterally-protruding tip portion. One of ordinary skill in the art would not have made such a modification because (a) it would weaken a structurally significant part of the upper jaw in a product where strength of the jaws is critical, and (b) it would complicate the manufacture of the upper jaw.

Accordingly, the '023 patent, as understood by one of ordinary skill in the art, teaches away from the Examiner's proposed modification because it would have interfered with or eliminated an advantageous rhino horn of the shears shown in the '023 patent.

D. The Objective Evidence of Non-Obviousness Is Compelling

Even if the proposed modification to the '023 patent's piercing tip presented a *prima facie* case of obviousness (it does not), the compelling objective evidence of non-obviousness proves that the present claims are not obvious over the '023 patent. The Federal Circuit explains:

Under *Graham* [*v. John Deere Co.*, 383 U.S. 1, 17–18 (1966)], objective evidence of nonobviousness includes *commercial success*, longfelt but unresolved need, failure of others, and *copying*. When present, such objective evidence *must be considered*. It can be the most probative evidence of nonobviousness in the record and enables the district court to avert the trap of hindsight.

Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d 955, 960, 1 U.S.P.Q.2d (BNA) 1196, 1199 (Fed. Cir. 1986) (emphasis added). "[E]vidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-39, 218 U.S.P.Q. (BNA) 871, 879 (Fed. Cir. 1983). Here, the nonobviousness of the pending claims is demonstrated by (1) the invention's commercial success, (2) reformed infringers' copying of and subsequent acquiescence to the patentable

strength of the claimed invention, and (3) the European Patent Office's grant of the counterpart European patent application.

1. The Commercial Success Of The Invention Proves Its Nonobviousness

To establish commercial success, Applicants must establish A) the commercial success of a product embodying the invention, and B) "a nexus ... between the sales and the merits of the claimed invention," i.e., that the commercial success was "a direct result of the unique characteristics of the claimed invention." *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996). The attached declaration of Clayton Sederberg ("Sederberg Decl.") demonstrates both of these requirements.

Specifically, the pending independent claims cover Stanley's MSD Saber series of shears, the upper jaw thereof, and/or the indexable piercing tip thereof. *See* Sederberg Decl., ¶ 4. In view of the high sales price for each of these heavy-duty shears, the sale of over 800 such MSD Saber series shears demonstrates the commercial success of the invention-embodiment product. *See* Sederberg Decl., ¶ 7. The commercial success is further demonstrated by the fact that Stanley incorporated the present invention into 96% of the shears that it has sold since 2005. *See* Sederberg Decl., ¶ 6.

The nexus between the commercial success and the claimed invention is demonstrated by the fact that Stanley was not able to successfully commercialize the shears shown in FIG. 10 of the commonly owned '023 patent with a non-indexable piercing tip, but did successfully commercialize the shears with the indexable piercing tip according to the present invention. *See* Sederberg Decl., ¶¶ 3-7. The nexus between the commercial success and the claimed invention is further demonstrated by the fact that "the ability to index the piercing tip enables customers to get twice as much use out of this wearable, replaceable component," which effectively doubles the value to the customer. Sederberg Decl., ¶ 8. Moreover, the nexus between the commercial success of the present invention and the Saber shears' inclusion of the claimed invention is further demonstrated by the fact that the claimed indexable piercing tip is not only twice as useful as the non-indexable piercing tip in the '023 patent, but is also 33% less expensive to manufacture. *See* Sederberg Decl., ¶ 5. "This cost savings is directly attributable to the fact that the 'metal tip portion disposed at each of said two ... ends, each said tip portion protruding laterally with respect to a surface of said central region,' as recited each pending independent claim, requires less machining than the non-indexable tip of the '023 patent." Sederberg Decl., ¶

5. Thus, the presently claimed indexable tip has provided Stanley with substantial cost savings that simultaneously provide the customer with a piercing tip that has twice the useful life. *See Sederberg Decl.*, ¶ 5.

Further still, the fact that two of Stanley's competitors, Genesis and Trevi Benne, copied the claimed invention to sell themselves, proves the commercial significance and success of the invention. *See Sederberg Decl.*, ¶¶ 9-10 and 12-13; *see also Bose Corp. v. JBL, Inc.*, 112 F. Supp.2d 138, 156 (D. Mass. 2000) ("[an infringer's] adulation of the [product] is the best evidence of the extent of its commercial success."). Indeed, these competitors' "imitation is the sincerest form of flattery." *Ingersoll-Rand Co. v. Brunner & Lay, Inc.* 474 F.2d 491, 497, 177 USPQ 112, 116 (5th Cir. 1973).

This compelling evidence proves that the presently claimed invention has been commercially successful and that that success is directly attributable to its use of the presently claimed invention. Such commercial success of the invention proves that the pending independent claims are nonobvious.

2. Competitors' Copying of the Invention and Subsequent Respect for the Value of the Claimed Invention Proves Its Nonobviousness

Competitors' copying of the presently claimed invention further demonstrates its nonobviousness. *See Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1284-86 54 USPQ.2d 1673, 1681-82 (Fed. Cir. 2000) ("Objective considerations such as ... copying may often be the most probative and cogent evidence of nonobviousness.") (citations and quotations omitted). Here, Genesis and Trevi Benne have both copied and infringed the indexable piercing tip independent claims (e.g., claims 1, 3, 4, 42) and Trevi Benne also copied and infringed the jaw and shears independent claims (e.g., claims 5, 7, 10, 12, 14, 16, 18-20). *See Sederberg Decl.*, ¶¶ 9, 12; *see also Sederberg Decl.*, Exs. B and F (photographs of the copied indexable piercing tips, jaw, and shears).

The significance of these competitors' copying of the claimed invention is highlighted by the fact that the prior art is riddled with conventional piercing tips, even Genesis' own indexable piercing tip, yet the value of the present invention was so significant that both Genesis and Trevi Benne felt compelled to copy Stanley's indexable piercing tip rather than use a conventional piercing tip. *See, e.g.*, U.S. Patent No. 6,926,217, FIG. 8 (illustrating Genesis' own indexable piercing tip 70); U.S. Patent Nos. 6,061,911, 6,119,970, and 6,839,969 (illustrating Genesis' own

additional conventional piercing tips); U.S. Patent No. 5,992,023, FIGS. 1, 4, 7, 9 (illustrating four different conventional piercing tips); U.S. Patent No. 6,994,284 (illustrating another conventional piercing tip); *Panduit Corp. v. Dennison Mfg. Co.* 774 F.2d 1082, 1099, 54 USPQ.2d 337, 349 (Fed. Cir. 1985) (“That Dennison, a large corporation with many engineers on its staff, did not copy any prior art device, but found it necessary to copy the cable tie of the claims in suit, is equally strong evidence of nonobviousness.”); *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 991, 6 USPQ.2d 1601, 1608 (Fed. Cir. 1988 (“[T]he infringer closely copied the invention in the ... patent. Copying the claimed invention, rather than one in the public domain, is indicative of unobviousness.”) (citations and quotation omitted).

When Stanley informed Genesis and Trevi Benne of Stanley’s intellectual property rights and the present application, both competitors agreed to stop their infringement. *See* Sederberg Declaration, at ¶¶ 10, 13; *see also id.* at Ex. C, 2/28/06 letter from Stanley’s counsel to Genesis (disclosing the present application and demanding that Genesis stop selling indexable piercing tips covered by the claims of the present application); *id.* at Ex. D, 3/10/06 letter from Genesis’ counsel to Stanley’s counsel (“Genesis has decided to stop making and selling a rotatable indexable shear tip for use with Stanley LaBounty’s MSD Saber shears.”); *id.* at Ex. G, 6/13/06 letter from Stanley’s counsel to Trevi Benne (disclosing the present application and counterpart European application to Trevi Benne stop); *id.* at Ex. H, 8/9/06 letter from Trevi Benne’s counsel to Stanley’s counsel (“Trevi Benne is ready to eliminate the reversible plates of CS series shears replacing them by irreversible plates...”). These competitors’ acquiescence to the value and strength of Stanley’s present invention further demonstrates the presently claimed invention’s nonobviousness. *Cf. In re Mahurkar Patent Litigation*, 28 U.S.P.Q.2d (BNA) 1801, 1820 (N.D. Ill. 1993), *aff’d*, 71 F.3d 1573 (Fed. Cir. 1995) (“The settlement of patent litigation may be functionally identical to a license – indeed, often includes an explicit license – and the willingness of other firms to take licenses is one secondary indicator of validity.”). Genesis and Trevi Benne are well positioned to be aware of any and all relevant prior art. Had either of these competitors been aware of prior art that would render the present claims obvious, they surely would have asserted such prior art. The absence of any such assertions further demonstrates the nonobviousness of the presently claimed invention.

3. The European Patent Office Found the Present Invention Patentable

The European Patent Office allowed and issued the European counterpart to the present application, i.e., European Patent No. 1,682,299 B1 (“the EP ‘299 patent”) (copy enclosed as Ex. E to the Sederberg Decl.). The claims of the EP ‘299 patent are as broad or broader than the presently pending claims. *See id.* The European Patent Office’s allowance and issuance of such claims further demonstrates their nonobviousness, especially in view of the fact that the European Patent Office explicitly considered the ‘023 patent and ultimately found the claims patentable over it. *See* WO 2005/044493 A1 (PCT counterpart to the present application), at Search Report (European Patent Office citation of the ‘023 patent).

4. Conclusion

Any one of the above objective criteria would be sufficient to demonstrate the invention’s nonobviousness. The presence of all of them provides compelling and objective proof that the pending claims are nonobvious.

E. Conclusion

For these reasons, Applicants respectfully submit that the Examiner’s proposed modification of the piercing tip in the ‘023 patent would not have been obvious to one of ordinary skill in the art. Applicants therefore respectfully request the withdrawal of the obviousness rejection of the present claims.

III. DEPENDENT CLAIM 46

Applicants also specifically traverse the obviousness rejection as applied to dependent claim 46, which recites, among other things, “a first notch [that] extends into the central region from the first generally planar edge surface,” and “a second notch [that] extends into the central region from the second generally planar edge surface.” The ‘023 patent does not disclose or suggest such a combination of recitations. Applicants identified this deficiency in the Examiner’s ‘023 patent-based obviousness rejection on page 13 of Applicants’ December 26, 2006 Response, but the February 11, 2008 Office Action has not substantively responded to Applicants’ arguments. Nor has the February 11, 2008 Office Action identified how the ‘023 patent discloses or renders obvious the combination of recitations in claim 46. Applicants therefore respectfully request the withdrawal of the obviousness rejection of claim 46 over the ‘023 patent.

IV. CONCLUSION

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance, and a Notice to that effect is requested.

If the Examiner has any questions or suggestions that will further prosecution of this application, the Examiner is encouraged to contact the undersigned at the below-listed telephone number.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975 under our Order No. 081776-0306363. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,
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Attachment: Sederberg Declaration